

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH A. HIPPELY, LARRY R. WOOD,
BRIAN E. WALSH and TERENCE A. CHOY

Appeal No. 97-3987
Application No. 08/387,047¹

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 10, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed February 10, 1995.

BACKGROUND

The appellants' invention relates to a thermochromic toy vehicle playset having a robot arm detailer. An understanding of the invention can be derived from a reading of exemplary claims 1, 5 and 8, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hippely et al. (Hippely)	4,961,716	Oct. 9, 1990
Langer ²	1,578,242 (Germany)	Nov. 6, 1962
Goldfarb	2,092,463 (United Kingdom)	Aug. 18, 1982

Claim 4 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

² In determining the teachings of Langer, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellants' convenience.

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Claims 1 through 3, 5 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hippely.

Claims 4 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hippely.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hippely in view of Goldfarb.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hippely in view of Goldfarb and Langer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed April 24, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 10, filed March 3, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness issue

We will not sustain the examiner's rejection of claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

The examiner determined (answer, p. 3) that the lack of antecedent basis for "said liquids" rendered the claim indefinite.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the

claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.

See Ex parte Porter, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992).

In this case, we agree with the appellants' position (brief, p. 11) that the recitation of "a hot liquid reservoir and a cold liquid reservoir" in parent claim 1 renders the language "said liquids" definite under 35 U.S.C. § 112, second paragraph. That is, it is our view that the scope of the invention sought to be patented by claim 4 can be determined from the language of the claims with a reasonable degree of certainty. Accordingly, the decision of the examiner to reject claim 4 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation issues

We will not sustain the examiner's rejection of claims 1 through 3, 5 and 6 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied,

465 U.S. 1026 (1984). However, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference. Id.

Claims 1 through 3

Claims 1 through 3 each set forth that the playset comprises, inter alia, (1) a trackway having an entrance gate and an exit gate; (2) a dual tank unit supporting a hot liquid reservoir and a cold liquid reservoir and defining first and second ramps through the hot liquid reservoir and the cold liquid reservoir respectively; (3) a base supporting the dual tank unit so as to align a selected one of the ramps to extend between the entrance gate and the exit gate; (4) a receiving station; and (5) a robot arm.

Hippely teaches a playset which includes (1) a trackway having an entrance portion (i.e, ramp member 34, annular track section 40 and pickup station B) and an exit gate (i.e, exit station B); (2) a dual tank unit supporting a hot liquid reservoir and a cold liquid reservoir (i.e, immersion station C and tanks 82); (3) a base supporting the dual tank unit (i.e, cover member 14); (4) a receiving station (i.e, track surface 85); and (5) a robot arm (i.e, robotic arm apparatus 12).

We agree with the appellants' argument (brief, pp. 6-7) that Hippely does not anticipate claims 1 through 3. In that regard,

we agree that the claimed ramps do not read on the bottom surfaces of Hippely's tanks 82. Furthermore, Hippely's base (i.e, cover member 14) does not support the tanks 82 so as to align a selected one of the tanks to extend between the entrance gate and the exit gate.

Since each element of claims 1 through 3 is not found in Hippely, the decision of the examiner to reject claims 1 through 3 under 35 U.S.C. § 102(b) is reversed.

Claims 5 and 6

Claims 5 and 6 each set forth that the playset comprises, inter alia, (1) a dual tank unit supporting first and second liquid filled tanks having respective first and second ramps therethrough; (2) a track set having a travel path for guiding a toy vehicle through the first tank via the first ramp; (3) a receiving station; and (4) a robot arm.

We agree with the appellants' argument (brief, pp. 6-7) that Hippely does not anticipate claims 5 and 6. In that regard, we agree that the claimed ramps do not read on the bottom surfaces of Hippely's tanks 82. Furthermore, Hippely does not provide a

travel path for guiding a toy vehicle through the first tank via the first ramp.

Since each element of claims 5 and 6 is not found in Hippely, the decision of the examiner to reject claims 5 and 6 under 35 U.S.C. § 102(b) is reversed.

The obviousness issues

We will not sustain the examiner's rejection of claims 4 and 7 through 10 under 35 U.S.C. § 103.

Claims 4 and 7

The decision of the examiner to reject dependent claims 4 and 7 is reversed since the all the limitations of their parent claims (i.e., claims 1 and 5) are not taught by Hippely for the reasons set forth above.

Claims 8 and 9

Claims 8 and 9 each set forth that the playset comprises, inter alia, (1) a dual tank unit having first and second liquid filled tanks and first and second toy vehicle trackways therethrough; (2) a first track segment for guiding a toy vehicle

to enter the first tank and traverse the first toy vehicle trackway; (3) a second track segment for guiding a toy vehicle emerging from the first tank; and (4) a robot arm.

We agree with the examiner's determination (answer, p. 5) that it would have been obvious to provide Goldfarb's toy vehicle wash apparatus as a segment leading to Hippely's toy vehicle playset. However, we also agree with the appellants' argument (brief, pp. 6-7 and 9) that the combined teachings³ of Hippely and Goldfarb would not have rendered obvious the subject matter of claims 8 and 9. In that regard, we agree that the claimed first and second toy vehicle trackway do not read on the bottom surfaces of Hippely's tanks 82. Furthermore, there is no teaching or suggestion in the applied prior art to provide a first track segment for guiding a toy vehicle to enter the first tank and traverse the first toy vehicle trackway. That is, there is no suggestion of providing a trackway to the tanks 82 of Hippely.

³ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Since the subject matter of claims 8 and 9 is not suggested by the applied prior art, the decision of the examiner to reject claims 8 and 9 under 35 U.S.C. § 103 is reversed.

Claim 10

We have also reviewed the reference to Langer applied in the rejection of claim 10 but find nothing therein which makes up for the deficiencies of Hippely and Goldfarb discussed above.

Accordingly, the decision of the examiner to reject claim 10 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 4 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 1 through 3, 5 and 6 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 4 and 7 through 10 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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APPLICATION NO. 08/387,047

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APJ COHEN

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 06 Jul 98

FINAL TYPED: